

Application No. 10/788,648
Response Dated November 16, 2005
Reply to Office Action of September 19, 2005

REMARKS/ARGUMENTS

1. Remarks of the Amendment

Claim 6 has been amended to a dependent claim of Claim 1.

Claims 7-9 have been canceled, as they are redundant after the amendment of Claim 6.

Antecedent basis of the amendment can be found in the Specification and drawings as filed. Applicant states that no new matter has been introduced by the amendment.

2. Argument on the Restriction Requirements

The Examiner has required in the Office Action dated September 19, 2005, that pursuant to 35 USC §121, the subject application be restricted to one of the alleged two "inventions" of Invention I (Claims 1-19) and Invention II (Claims 20-21). The Examiner has further required the Applicant to elect one of four alleged patentably distinct species. Responding thereto, Applicants hereby elect, with traverse, the Invention I presently defined by Claims 1-19, and Species I presently defined by Figures 1-2, 2A, 3 and 3A, and Claims 1-6. Applicant respectfully requests reconsideration and withdrawal of the restriction requirement.

The Examiner contends that the "invention" in Invention I (Claims 1-19) and Invention II (Claims 20-21) are distinct as explained by MPEP §806.05 (f). The Examiner states that Inventions I and II are related as a process of making and product made, and in the instant case the product can be made by employing any other suitable securing means other than adhesive to fasten the sliding coupler to the fitting.

Applicant respectfully believes that the restriction is improper, because apparently the Examiner has misunderstood Applicant's claimed invention. In the instant application, Invention I claims are directed to a slide coupling fitting for

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connecting a conduit. Invention II claims are directed to a method of using the slide coupling fitting defined in Invention I claims for connecting to a conduit. Therefore, Applicant's claimed invention is not a process of making a product, rather a product and a method of using the claimed product.

More importantly, the same structural features of the slide coupling fitting are defined by both Claim 1 (Invention I) and Claim 20 (Invention II). In the method defined by the alleged Invention II, each step of the method is directly related to and depended on the structure of the product of Invention I.

Furthermore, a critical reading of the restriction requirements finds that the two groups of claims do not meet the requirements for the restriction. More specifically, the requirement in MPEP 806.4 states that the Examiner needs to show that the two or more inventions are distinct and independent.

The Examiner is requested to reconsider the restriction requirement under 35 USC §121 to elect a single invention. The requirements of §121 are that the inventions be independent and distinct. Both requirements are necessary to maintain a restriction requirement. Applicant maintains that the Examiner has not focused upon the two requirements of being independent and distinct. It is noted that M.P.E.P. §802.01 provides a definition of independent as follows:

The term "independent" [i.e., not dependent] means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect, for example, [1] species under a genus which species are not usable together as disclosed or [2] process and apparatus incapable of being used in practicing the process.

Applicant contends that Inventions I and II inventions are not independent of each other, because the structure of the slide coupling fitting is claimed in both Inventions I and II.

Applicant has endeavored to particularly point out and distinctly claim their invention. Applicant submits that the embodiments identified by the Examiner would

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all be found in the same general search and hence would not require any undue searching by the Examiner. Furthermore, the search required for Invention I is also required for Invention II, because the same device is used in the method of Invention II.

Notwithstanding, Applicants appreciate the Examiner's desire to separate the group inventions, but it is not readily understood that examining Inventions I and II together would cause a serious burden on the PTO.

On the other hand, the alleged two Inventions resulting from the restriction requirement would cause Applicants additional expenses and time to prosecute separate patent applications. The burden placed upon Applicants for filing separate cases directed to each of the Inventions is respectfully submitted not to be outweighed by the burden placed upon the Patent Office by a coextensive examination of these groups in one application.

Applicants believe that it would be more efficient to examine all the claims rather than expend additional time prosecuting divisional applications relating to the specific Invention I or Invention II "inventions." Consequently, in the interest of efficiency, it is respectfully submitted that the restriction requirement is untenable and ought to be withdrawn as to Inventions I and II.

For the above reasons, reconsideration of the restriction requirements for the alleged two Inventions set for in the outstanding Office Action is respectfully requested.

Furthermore, the Examiner contends that the instant application contains four patentably distinct species, i.e., Species I (Figures 1-2, 2A, 3 and 3A), Species II (Figures 4-6), Species III (Figures 7-8) and Species IV (Figure 9).

Applicant refers to MPEP §802.01, 806.04(a)-(i) and 806.05-806.05(i) for support that the restriction is inappropriate. As provided therein, the question of restriction must be determined by both the practice applicable to election of species and the practice applicable to other types of restriction. If restriction is improper under either practice, it should not be required.

More specifically, Species II currently defined by Figures 4-6 has all structural

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features of Figures 1-3, with additional middle coupler for connecting to an additional conduit. As apparent from the amendment, the middle coupler as defined by the amended Claim 6 is dependent on Claim 1 (Species I). Therefore, the alleged Species II is not separated from, nor independent of Species I, and Claim 1 is generic to both Species I and II. Similarly, the alleged Species IV (Claims 16-19) is dependent on the alleged Species III (Claims 10-15), as evident by the claim dependency.

More importantly, all four alleged Species contain the sliding coupler, as shown by the drawings and defined by the claims. A general search of Applicant's claimed slide coupling fitting comprising a sliding coupler will cover all four alleged Species.

Therefore, Applicant respectfully requests the Examiner's reconsideration of the restriction of the Species.

Furthermore, Applicant submits that upon the allowance of a generic claim, Applicant is entitled to consideration of claims to additional species which are written in dependent form, or otherwise include all the limitation of the allowed generic claim as provided by 37 CFR1.141.

11/16/2005
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